

REMARKS

Claims 1 and 4 are pending in this application. By this Amendment, claims 1 and 4 are amended. The Amendment is supported by the specification at least at paragraph [0035]. No new matter is added.

The courtesies extended to Applicants' representative by Examiner Echelmeyer at the personal interview held on March 5, 2010, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below, which constitute Applicants' separate record of the substance of the interview. Reconsideration based on the amendments and following remarks is respectfully requested.

I. The Claims Define Allowable Subject Matter

The Office Action rejects claims 1 and 4 under 35 U.S.C. §102(b) over Lane (U.S. Patent No. 6,569,564). The rejection is respectfully traversed.

Specifically, as discussed during the interview, Lane does not disclose at least that the end part of one container member and the end part of the other container member are bonded *adhesively* to each other only by the epoxy resin, as recited in independent claim 1, and similarly recited in independent claim 4.

The Office Action, on page 3, states that "Lane fails to explicitly teach that the epoxy adhesive, yet the skilled artisan would easily recognize that this is an inherent material property, for example *in light of Applicant's disclosure* [0035]" (emphasis added). This conclusion is at least admittedly based on improper hindsight reasoning as the conclusion is reached on the basis of knowledge gleaned only from Applicants' disclosure. *See* MPEP §2145.

As conceded by the Office Action, Lane does not disclose that the epoxy is adhesive. Lane states that "[a]n electrically insulative sealing gasket 32 is included, and is sized to *matingly fit* within the periphery of can 12. An example preferred material for *gasket 32 is*

epoxy. Gasket 32 provides electrical insulating *separation* between first terminal housing member 12 and second terminal housing member 14 upon sealing engagement as will be apparent from the continuing discussion" (emphasis added). *See* col. 3, lines 61-67.

However, in the continuing discussion, Lane does not disclose any setting of gasket 32 (*e.g.*, external heating) after or upon installation of gasket 32 to be adhesive, and thus to bond adhesively first terminal housing member 12 and second terminal housing member 14. *See* paragraph [0035] of the present application. Thus, Lane, as a whole, only appears to disclose that gasket 32 is a firmed or hardened epoxy structure not having adhesion. In fact, as disclosed above by Lane, gasket 32 is sized to *matingly fit* within the periphery of can 12. This implies that gasket 32 is not bonding adhesively. If gasket 32 has adhesion, it would be difficult to make the container dish like gasket 32, as shown in Fig. 1, matingly fit within the periphery of can 12. Indeed, according to Lane's disclosure, the purpose of using gasket 32 is to provide electrical insulating *separation* between first terminal housing members 12 and second terminal housing members 14. Lane does not disclose bonding *adhesively* between first terminal housing members 12 and second terminal housing members 14 by gasket 32, but separation.

Moreover, Lane discloses that first terminal housing members 12 and second terminal housing members 14 are joined together into a finished sealed battery assembly 50 and that the finished sealed assembly is typically accomplished by *crimping* the peripheries of the first and second terminal housing members together. *See* col. 4, lines 37-45. Thus, Lane fails to suggest any need for bonding adhesively the housing members 12 and 14 by gasket 32 for joining them together since the housing members are already crimped. There is no suggestion of adhesion in any of the disclosure of Lane.

Finally, the Office Action's assertions regarding an inherent property based on the disclosure of Lane fail to meet the applicable standard for such a showing. It is well

understood that anticipation can only be shown where the reference used teaches every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. MPEP §2112 states that the Patent Office must provide rationale or evidence tending to show inherency. Citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1990), §2112 states, "[i]nherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Additionally, citing *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), §2112 states, "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis in original). The Office Action, at least for the reasons set forth above, fails to meet this standard for a showing that the alleged feature "necessarily" flows from the teachings of the reference. For at least the admission that Lane does not explicitly teach the recited feature, and the failure of the Office Action to apply the applicable standard for showing inherency, the rejection necessarily fails.

For at least the foregoing reasons, Lane does not disclose explicitly, or inherently, any feature that can reasonably be considered to correspond to the recited at least the end part of one control member and the end part of the other container member being bonded adhesively to each other only by the epoxy resin. Thus, claims 1 and 4 are allowable. Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 4 under 35 U.S.C. §102(b) is respectfully requested.

In view of the foregoing it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the pending claims 1 and 4 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Request for Continued Examination
Petition for Extension of Time

Date: March 18, 2010

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